

DOCKET NO.: VTN5003
Application No.: 10/692,088
Office Action Summary Dated: January 12, 2006

PATENT

REMARKS/ARGUMENTS

Claims 1-19 are rejected under 35 U.S.C., 112, first paragraph because the specification, while being enabling for saline solutions, organic solvents, deionized water, buffered aqueous solutions, does not reasonable provide enablement for any second liquid.

Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention and as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Driscoll et al (3829329).

Claims 1-3 and 7-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ayyagari et al. (WO01/45868A1).

Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ayyagari et al. WO01/45868A1) in view of Qui et al. (2004/18295).

Claims 1, 4-5 and 18 have been amended and claim 20 has been added. No new matter has been added.

I. Rejections under 35 U.S.C. 112

Claims 1-19 are rejected under 35 U.S.C., 112, first paragraph because the specification, while being enabling for saline solutions, organic solvents, deionized water, buffered aqueous solutions, does not reasonable provide enablement for any second liquid.

Claim 1 has been amended to read that the second liquid comprises at least one of a saline solution, an organic solvent, deionized water and buffered aqueous solutions

Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Applicants respectfully traverse this rejection.

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Paragraph 0068 of the specification explicitly describes swelling a lens to 18.1mm and back to the functional size of the lens of 14.0mm. Accordingly, the Applicants did convey possession of the invention.

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner rejected claim 1-19 contending that one skilled in the art would not understand the term functional size. The Applicants respectfully traverse this rejection.

The functional size of a contact lens is well understood to one skilled in the art and the specification provides for a specific example of functional size in paragraph 0068, wherein it states that the functional size of the lens in the example is 14.0 mm. The Applicants respectfully refer the Examiner to Tyler's Quarterly Soft Contact Lens Parameter Guide which is replete with reference to the functional sizes of contact lenses as they will be provided to a customer. The Applicant submits that one skilled in the art understands a functional size, just as a patent directed to a tire for an automobile would not have to list every available size, or a patent directed to a hat would not have to list every available size, in order to be understood, neither would does every possible size that contact lens can be designed to be made needs to be listed in the specification.

The Applicants further note that paragraph 0011 specifically notes that in some embodiments swell can be viewed as an increase in diameter of at least 1mm, which has been incorporated into new claim 20.

Claim 4 has been amended to provide an antecedent basis for the "said salt solution" of claim 6.

Claim 18 has been amended to specifically claim a hydrogel comprising etafilcon and claim 19 has been cancelled.

II. Rejections under 35 U.S.C. 103(a)

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Driscoll et al (3829329). The Applicants respectfully traverse. O'Driscoll is directed to methods of "toughening" a lens and cleaning material from the eye from the lens. O'Driscoll is not directed to swelling a lens to extract excess materials which include unbound

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monomer, unbound polymer, and colorant, as presently claimed. Applicant's therefore respectfully request that the claims, as amended, be passed on to allowance.

Claims 1-3 and 7-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ayyagari et al. (WO01/45868A1). Applicant respectfully traverses these rejections. Ayyagari describes exposing a lens to a primary solvent, such as carbon dioxide and a co-solvent such as isopropyl Alcohol (IPA). Ayyagari does not teach exposing the lens to a first liquid comprising one of: a saline solution, an organic solvent, deionized water and buffered aqueous solutions and then a second liquid comprising one of: a saline solution, deionized water and buffered aqueous solutions. In addition, Ayyagari does not describe or teach exposing the lens to a first solution with a higher ionic strength and a second solution of lower ionic strength.

Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ayyagari et al. WO01/45868A1) in view of Qui et al. (2004/18295). Applicant respectfully traverses this rejection for pending claim 18 since neither Ayyagari nor Qui describes or suggests practicing the steps taught in claim 1 on a contact lens comprising "etafilcon A".

III. Conclusions

Applicants request the Examiner to:

- (1) enter the amendments to claim 1, 4-5 and 18;
- (2) enter new claim 20;
- (3) reconsider and withdraw the standing rejections of the claims; and
- (3) pass claims 1-18 and 20 to allowance.

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If the Examiner is of a contrary view, the Examiner is requested to contact the undersigned attorney at (904) 443-3731.

Respectfully submitted,

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Date: June 6, 2006

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